

REMARKS

Amendments

Amendments to the Claims

Applicants have amended the claims to clarify what Applicants regard as the invention. Particularly, it is the utility program that dynamically selects an image for insertion into a markup language document. No new matter has been added as a result of these amendments.

Rejections

Rejections under 35 U.S.C. §103

Claims 1-11, 13, 15 and 19-24

Claims 1-11, 13, 15 and 19-24 were rejected under the 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,745,681 to Levine et al ("Levine").

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that Levine does not teach the invention as claimed in claims 1-11, 13, 15 and 19-24 and assume that the Examiner is taking Official Notice of the missing elements. Applicants respectfully object to such Official Notice and requests the Examiner cite references in support of his position.

Levine discloses a stateless shopping cart for online shopping in which the shopping cart's content is stored at the client's side. Levine also discloses a shopping page for device drivers that is arranged in a selectable list by alphabetical order. When

user requests a list of drivers, the server invokes the market program to generate and transmit a shopping page file to the browser. Shopping pages built from the shopping page files contain items that are selectable by the user.

Independent claims 1 and 19 recite a computerized method for dynamically selecting an image for a markup language document. Independent claim 13 recites a utility program for retrieving images from a group of images using a set of random numbers.

The Office Action states that it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the teachings of Levine in order to arrive at the present invention as claimed. However, Levine simply does not disclose:

encoding an instruction in the markup language document, the instruction **identifying a utility program** that dynamically selects an image for insertion into the a method for dynamically selecting images for a makeup language document using document; ...invoking the **utility program** when the instruction is processed; selecting, **by the utility program**, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction; and placing, **by the utility program**, the pre-determined number of images in the markup language document at locations defined in the instruction. (Claim 1 as amended).

In addition, Levine teaches storing user selected items by the browser. Levine does not teach or suggest a set of random numbers as claimed in claim 13. Rather Levine discloses at column 2, lines 15-23 that the user selects the items, not the market program. Furthermore, Levine contains no mention whatsoever with respect to using random numbers as claimed. Hence, Levine does not teach a utility program for dynamically selecting images for a makeup language document using a set of random numbers.

As discussed above with respect to claim 13, Levine does not teach a utility program that dynamically selects images for insertion into the document as claimed in claims 1 and 19, but that the user selects the items for insertion.

As discussed above with respect to claim 1 and 13, Levine does not disclose a utility program that determines a number of images to be displayed in the markup text document as claimed in claim 19 because instead it is the user that determines the items to be inserted into the markup text document.

Accordingly, Applicants respectfully submits that the invention as claimed in the independent claims 1, 13 and 19 and claims 2-11, 15 and 20-24 that depend from the independent claims, is not rendered obvious by Levine, and respectfully request the withdrawal of the rejection under 35 U.S.C. §103(a).

Claims 12 and 14

Claims 12 and 14 stand rejected under 35 U.S.C. §103(a) as being obvious over Levine in view of U.S. Patent No. 6,704,797 to Fields et al. ("Fields"). Claim 12 and 14 are dependent on claims 1 and 13 respectively and incorporate their limitations. Applicants respectfully submit that the combination of Levine and Fields does not teach each and every element of the invention as claimed in claims 12 and 14.

As discussed above, Levine teaches a stateless shopping cart in which the market program inserts into shopping page files items selected by the user. Fields discusses server based policy that results in the selective distribution of one of multiple versions of an original image. In addition, Fields teaches a server based policy to evaluate a given rule against a set of client-specific data such as the identity of the referring page or existence of user authentication.

Because Applicant's claims 12 and 14 depend from claims 1 and 13, Fields must disclose a utility program that dynamically selects an image for insertion to have a proper *prima facie* case of obviousness. As neither Levine nor Fields teach or suggest a utility program that dynamically selects an image for insertion, the combination cannot render obvious Applicant's invention as claimed in claims 12 and 14. Furthermore neither reference teaches validation based on image-specific data as claimed. Therefore, Applicants respectfully request the withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over the combination of Levine and Fields.

SUMMARY

Claims 1-15 and 19-24 are currently pending. In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance. Applicant respectfully requests reconsideration of the application and allowance of the pending claims.

If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact Sue Holloway at (408) 720-3476.

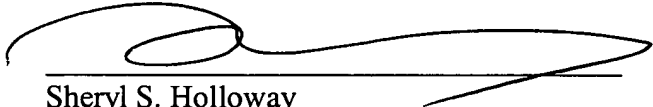
Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such extension.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR
& ZAFMAN LLP

Dated: July 16, 2004



Sheryl S. Holloway
Attorney for Applicant
Registration No. 37,850

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-3476